

Claim 5 particularly points out and distinctly claims the recited subject matter in a definite and unambiguous manner. The test for compliance with 35 U.S.C. §112, second paragraph, is whether one of ordinary skill in the art would readily understand the terms when read in the context of the claim, and further, when read in light of the specification. Claim 5 is clear on its face. That is, one of ordinary skill in the art would readily understand the terms "turning speed of the revolving machining tool," "turning speed of the held plastic lens," and "number of revolutions of the plastic lens," particularly when read in the context of claim 5. Moreover, one of ordinary skill in the art would readily understand these terms when read in light of the specification. For example, paragraphs [0164]-[0166] define each of the terms "turning speed of the revolving machining tool," "turning speed of the held plastic lens," and "number of revolutions of the plastic lens."

Regarding the Office Action's assertions with respect to the Table shown in Fig. 24 and described in paragraph [0169], Applicants submit that the table is an exemplary embodiment. The exemplary embodiment shown in the table does not conflict with the terms recited in the claims, nor with other portions of Applicants' disclosure as discussed above.

For at least the above reasons, reconsideration and withdrawal of the §112, second paragraph, rejection of claim 5 are respectfully requested.

The Office Action, in paragraph 4, rejects claim 5 under 35 U.S.C. §103(a) as being unpatentable over JP-A-64-016346 (hereinafter "JP '346"). The Office Action, in paragraph 5, rejects claim 5 under 35 U.S.C. §103(a) as being unpatentable over JP '346 in view of U.S. Patent No. 5,053,971 to Woods. These rejections are respectfully traversed.

Claim 5 recites, among other features, machining a plastic lens for spectacles held at its center such that a circumferential surface of the held plastic lens is edged away by a revolving machining tool for circumferential surface machining by causing the held plastic lens to revolve about the center of the plastic lens in order to edge away the circumferential

surface about an entire circumference of the held plastic lens, thereby machining the held plastic lens to a prescribed circumferential edge shape; and wherein the machining includes rough machining and finishing machining being performed by forcibly edging the plastic lens using the same revolving machining tool. JP '346, even in combination with Woods, would not have suggested these features.

JP '346 discloses a method for "milling by NC machining," an object of which is to form a surface shape of a member to be machined. If a machining method such as that disclosed in JP '346 is applied to machining of a spectacle lens, it could not be applied to a spectacle lens held at its center, and would not be applied such that a circumferential surface of the held plaque stick lens is edged away. Rather, the method disclosed in JP '346 would be applied to the formation of a curved surface shape of the lens main surface. An object of the machining method of JP '346 is to form the surface shape of the member to be machined. Thus, it is not necessary to change a machining condition, *i.e.*, control method of a tool, so as to be related to a thickness of the member to be machined (edge thickness according to claim 5). In fact, JP '346 neither discloses, nor would it have suggested, a technique of setting the thickness of the member to be machined.

In contrast, an object of the "edging process" recited in claim 5 is to form a prescribed spectacle frame shape (outer peripheral shape) from a circular shaped spectacle lens. Additionally, as the object of the method recited in claim 5 is to form the spectacle frame shape (outer peripheral shape), a step of specifying the edge thickness of a lens to be machined as a machining condition is a prerequisite. The conclusory statement drawn by the Office Action in this regard provides no reasonable bases to support the assertion that there would have been any predictability, or reasonable expectation of success, in modifying the device described in JP '346, drawn to a completely different type of milling, to achieve the types of results achieved by the subject matter of the pending claims. In this regard, the

machining method of JP '346 and the machining method recited in claim 5 are different from each other, and there is no evidence of predictability provided for completely modifying the device disclosed in JP '346 to obtain results such as those may be obtained by the subject matter of the pending claims.

Furthermore, according to the machining method of JP '346, metal is selected as a main machining object. As such, JP '346 does not teach, nor would it have suggested the technique of finely setting the control method of the tool according to its material. In contrast, according to the machining method of claim 5, the spectacle lens made of plastic is selected as a machining object, and one of its characteristics is to specify the kind of the plastic as a machining condition.

It should also be noted that the object of the machining method of JP '346 is to provide micro machining. Importantly, the machining method of JP '346 does not suggest performing the formation of the outer peripheral shape of the member to be machined by dividing the process into two steps including rough machining and finishing machining. In contrast, claim 5 recites performing the formation (edging) of the spectacle frame shape, by dividing the process into two steps including rough machining and finishing machining.

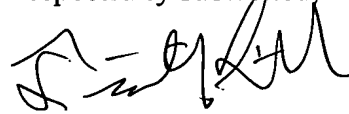
For at least the above reasons, JP '346 cannot reasonably be considered to have suggested the combination of all of the features positively recited in claim 5. Further, JP '346, even in combination with Woods, which is not applied in a manner that would overcome the above-identified shortfalls of JP '346 with respect to the subject matter of claim 5, would not have suggested the combination of all of the features positively recited in claim 5.

Accordingly, reconsideration and withdrawal of the prior art rejections of claim 5 are respectfully requested.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claim 5 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Attachment:  
Petition for Extension of Time

Date: February 19, 2008

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